

REMARKS

Reconsideration of the subject patent application is respectfully requested.

With regard to the seventeen (17) claims that are present pending in this application, the Examiner has indicated that claims 6-9, 13, 15, and 16 are objected to but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With regard to claims 1-5, 10-12, and 17, the Examiner has rejected these claims under 35 U.S.C. §103(a) as being unpatentable over Knapp in view of Black. The remaining claim, claim 14, is rejected under 35 U.S.C. §103(a) as being unpatentable over Knapp in view of Black as applied above and further in view of Breda.

With regard to the Examiner's rejection of independent claims 1 and 17, the Examiner correctly notes that Knapp does not disclose a diverter cartridge with a plurality of detent recesses, nor any cooperating cap with at least one deflectable detent finger. In terms of the 35 U.S.C. §103(a) rejection, the contention is that these (Knapp) deficiencies are supplied by Black and that it would be obvious to add the Black structures into Knapp. Applicant disagrees with this contention.

First, consistent with the Examiner's assessment of Knapp, noting that it does not disclose a diverter cartridge with a plurality of detent recesses nor any cooperating cap with at least one deflectable detent finger, neither does Black. A proper §103(a) rejection is believed to require two findings. First, the missing structures noted for the primary reference (Knapp) are in fact supplied by the secondary reference (Black). Secondly, it would be obvious to one of ordinary skill in the art to combine the two (or more)

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references and this requires some degree of compatibility for the various structures being combined as well as some direction, motivation, or teaching appearing in one or more of the references.

The Examiner has stated that the missing structures of Knapp, relative to the inventions recited in claims 1 and 17 include:

- (a) a diverter cartridge with a plurality of detent recesses; and
- (b) a cap with at least one deflectable detent finger.

These are thus the two structures that we must be able to find in Black if there is going to be satisfaction of the first requirement for a proper §103(a) rejection. The Examiner refers to elements 20 and 22 of Black as providing these missing structures. However, first shoulder means 20 of Black is configured as part of the threaded connection of shaft 50 through façade 90, preferably being inserted into clamp nut 44 (FIG. 8) or formed as part of wire finger element 84 (FIGS. 2 and 7). Element 20 is not part of a cap as recited in independent claims 1 and 17 and as missing in Knapp.

Element 22 is formed as part of the body portion 68 of control knob 16. Element 22 is not part of a diverter cartridge as recited in independent claims 1 and 17 and as missing in Knapp. Applicant submits that since Black does not provide either of the structures that are missing in Knapp, as acknowledged by the Examiner, the §103(a) rejection of independent claims 1 and 17 is not a proper rejection.

With regard to the question of obviousness, Black is not a flow diverter valve, merely a fluid control valve. The indexing that is enabled by Black is not for the selection of an outlet port of a combination of outlet ports to divert flow to one or more components. Instead, Black provides its "indexing" to simply fix the selected flow

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setting so that the desired mix of hot and cold water can be achieved. The purpose, function, and objectives of Black are different from those of Knapp and are different from those of the present invention. It is therefore questioned why the Examiner believes that (1) Black is relevant art, and (2) why anyone would be motivated to try and combine Black with Knapp.

Structurally speaking, without hindsight knowledge, it is virtually impossible to figure out how Knapp could even be changed to accept elements 20 and 22 of Black. However, we do know that change would be required and substantial or significant changes would be necessary in order to incorporate elements 20 and 22 of Black into Knapp. Based on the Black disclosure and what we learn from its specification, a person of ordinary skill in the art would most likely try to position element 20 around control pin 18 adjacent elastic ring 15. As for element 22, the person of ordinary skill in the art would most likely attempt to integrate element 22 into a control knob (not illustrated in Knapp).

Over the years the Court of Customs and Patent Appeals (CCPA) and more recently the Court of Appeals for the Federal Circuit (CAFC) have addressed the issue of what criteria is to be applied when combining two or more references under 35 U.S.C. §103. While the facts may differ from case to case and while the CAFC panel may change, the legal precedent established by the Board of Patent Appeals and Interferences and the CCPA has been followed and strengthened by the later cases of the CAFC. Clearly and succinctly stated, before obviousness may be established, the examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. Ex parte Kranz, 19 USPQ2d

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1216, 1218 (Bd. Pat. App. & Inter., 1990). The case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is vigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340 (Fed. Cir. 1998). Obviousness cannot be established by combining the teachings of prior art in order to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In re Geiger, 2 USPQ2d 1276 (Fed. Cir. 1987). It is improper to reject the claimed invention for obviousness when nothing in the cited references, either alone or in combination, suggests or teaches the claimed invention. Evidence of teaching or suggestion is "essential" to avoid hindsight. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988). Stated slightly differently, the mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence the claimed invention, obvious unless the desirability of such modification is suggested by the prior art. In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992).

It is generally accepted, however, that it is improper to change the basic principle under which the primary reference was intended to operate. In re Ratti, 123 USPQ 349 (CCPA 1959). It is not enough to pick out isolated features in earlier prior art patents, combine them in one particular way with the application of hindsight acquired only from the applicant's own disclosure, and then say that it would have been obvious to select those particular features and to combine them in the particular way in which the applicant has. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. There must be some teaching or suggestion in the

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references to support their use in the particular claimed invention. Smithkline
Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468 (Fed. Cir. 1988).

There must be some logical reason apparent from positive concrete evidence in the record that justifies a combination of primary and secondary references. In re Regel, Buchel and Plempel, 188 USPQ 136 (CCPA 1975). It is insufficient to show merely that each separate element of a claimed combination can be found in one or various prior art references. The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new invention does not necessarily render such new invention obvious unless the prior art also contains something to suggest the desirability of the combination. In re Gergen, 11 USPQ2d 1652, (Fed. Cir. 1989).

It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wessslau, 147 USPQ 391, (CCPA, 1965), Bausch & Lomb v. Barnes-Hind/Hydrocurve, 230 USPQ 416 (CAFC, 1986). Without the benefit of applicant's disclosure, a person of ordinary skill in the art would not know what portions of the reference to consider and what portions to disregard as irrelevant, or misleading. In re Mercier, 185 USPQ 774 (CCPA, 1975). Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. Interconnect Planning Corp. v. Feil, 774 F2d 1132 (Fed. Cir. 1985).

In view of the remarks and analysis that have been offered regarding the Knapp and Black references, independent claims 1 and 17 are believed to be allowable as well as

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dependent claims 2-16. The only changes to claims 1-17 are to claims 6, 13, 15 and 16. Claims 6, 13, and 15 have been amended and claim 16 has been canceled. The amending changes remain consistent with the Examiner's bases for allowance (i.e., objected to). New claims 19-22 are allowable as being drafted consistent with the Examiner's indication of allowability regarding claims 6, 13, 15, and 16. It is noted that new claim 19 is a combination of claims 1-6, new claim 20 is a combination of claims 1, 12, and 13, new claim 21 is a combination of claims 1, 14, and 15, and new claim 22 is a combination of claims 1 and 16. One further note pertains to new claim 21 and the specific text of claim 15 relative to claim 1. There did not appear to be an antecedent basis for the term "fingers" in claim 15 and thus the text of claim 1 was revised to refer to "a pair of detent fingers" as contrasted to the prior text of "at least one".

With regard to new claim 18, this claim is a combination of claims 1 and 6 and is believed to be allowable in that the recited element of claim 6 (and 13) was determined by the Examiner to constitute allowable subject matter. The basis of allowability did not appear to depend on whether there was one finger or more than one finger.

With regard to new claim 23, this claim is believed to be patentable in view of the recited structure that results in the flow option to disengage the inlet boss from the inlet port for diverting fluid to all outlet ports and thus to all devices.

Therefore, claims 1-15 and 17-23 are respectfully requested to be passed to issue. The addition of new claims 18-23 has resulted in an additional filing fee of \$1100 and payment is enclosed in the form of a credit card authorization form.

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Respectfully submitted,

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